

REMARKS

Claims 1-30 are pending in the application. Claims 1, 11, 19, and 25 are independent. By the foregoing Amendment, claims 1, 11, 14, and 17, have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 11-18 Under 35 U.S.C. §101

In the Office Action, the Examiner rejected claims 11-18 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, the Examiner states that in claim 11 “a machine-accessible medium is being recited; however, no definition or positive element for a medium was provided within applicant’s specification. It isn’t clear as to what type of medium the applicant intended to claim, but the term medium may be implemented as software if executed by a machine as the applicant claimed in lines 1-2 of claim 11. Neither of claims 12-18 resolve the deficiencies of claim 11 because neither of the claims identify a positive definition for the term “medium” and it would appear to one of ordinary skill in the art that the medium wouldn’t fall under the statutory categories of a process, machine, manufacture, or composition of matter, since the medium that the applicant is claiming can be executed by a machine.” Applicants respectfully traverse the rejection.

35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures, and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed). Once it is determined that the subject matter of the claimed invention falls into one of these categories, MPEP §2106.II.A provides that the Examiner must determine whether the claims fall within a judicial exception, such as a law of nature, a natural phenomenon, or abstract idea. Then, the Examiner must determine whether the claimed invention covers a judicial exception or practical application of a judicial exception, such as physical transformation or useful, tangible, and concrete result. The Examiner must then determine whether the claimed invention preempts a judicial exception, such as a law of nature, a natural phenomenon, or abstract idea. The Examiner must finally establish on the record a *prima facie* case that the claims are unpatentable. Only after

the Examiner has made out a *prima facie* case that the claims are unpatentable due to non-statutory subject matter does the burden shift to an applicant to either amend the claim or show why the claim is patentable.

Applicants respectfully submit, nonetheless, that the Examiner has not made out a *prima facie* case of unpatentability under 35 U.S.C. §101 with respect to claims 11-18. It appears that the standard for patentability the Examiner is using is incorrect. Applicants respectfully submit that “it would appear to one of ordinary skill in the art that the medium wouldn’t fall under the statutory categories of a process, machine, manufacture, or composition of matter, since the medium that the applicant is claiming can be executed by a machine” *is not the standard for determining patentability* of claims under 35 U.S.C. §101.

Applicants respectfully submit further that the Examiner has not shown that the subject matter in claims 11-18 are not processes, machines, manufactures, or compositions of matter. A mere statement that they are not processes, machines, manufactures, or compositions of matter does not make it so. Applicants respectfully submit further that the Examiner has not shown that the subject matter in claims 11-18 is a judicial exception such as a law of nature, a natural phenomenon, or abstract idea. As such, Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of unpatentability under 35 U.S.C. §101 with respect to claims 11-18. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 11-18.

Rejection of Claims 1, 7-9, 11, and 17-18 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 1, 7-9, 11, and 17-18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0024831 to Yang et al. (hereinafter “*Yang*”). Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d

1226, 1236 (Fed. Cir. 1989)). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants respectfully submit that *Yang* fails to disclose the identical invention as recited in claims 1 and/or 11. Independent claim 1 recites in pertinent part “***using a firmware unit to interact with a management module*** of the blade server during the management mode of operation to manage operation of the processing blade” (emphasis added). Independent claim 11 recites in pertinent part “***using a firmware unit to interact with a chassis management module*** (“CMM”) of the blade server during the management mode of operation to manage operation of the processing blade” (emphasis added). Support for these changes can be found in Applicants’ Specification at paragraph [0022] according to at least one embodiment and in original claims 19 and 25. Thus, Applicants respectfully submit that no new search is required.

In the Office Action, the Examiner states that *Yang* teaches activating a management mode of operation of a processor on a processing blade, the processing blade included within a blade server; interacting with a management module of the blade server during the management mode of operation to manage operation of the processing blade; and deactivating the management mode of operation of the processor. Applicants respectfully disagree.

Applicants respectfully submit that *Yang* fails to teach, either expressly or inherently, “***using a firmware unit to interact with a management module of the blade server during the management mode of operation to manage operation of the processing blade***” as recited in claim 1 (emphasis added) and/or “***using a firmware unit to interact with a chassis management module*** (“CMM”) of the blade server during the management mode of operation to manage operation of the processing blade” (emphasis added) as recited in claim 11. Because *Yang* fails to teach at least these elements of claims 1 and/or 11, Applicants respectfully submit that claims 1 and/or 11 are patentable over *Yang*.

Claims 7-9 properly depend from claim 1 and are thus patentable for at least the same reasons that claim 1 is patentable. Claims 17-18 properly depend from claim 11 and are thus patentable for at least the same reasons that claim 11 is patentable. (MPEP §2143.03 (citing *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1, 7-9, 11, and 17-18.

Rejection of Claim 19 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claim 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,931,475 to Huang et al. (hereinafter “*Huang*”). Applicants respectfully traverse the rejection.

Independent claim 19 recites in pertinent part “*a firmware unit* communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC *to communicate with the CMM during a management mode* of operation of the processor to coordinate operation of the processing blade with the CMM.

In the Office Action, the Examiner states that *Huang* teaches a processing blade, comprising: a processor to execute instructions, a communication link communicatively coupled to the processor, the communication link to communicatively couple to a chassis management module of a blade server, a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller, and a processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM. The Examiner asserts that because a KVM switch that is connected to the select button of the processor of the blade server has embedded implementations to control each server blade, and that because firmware is defined as software embedded into a hardware device and Applicants defined a VMC as a software entity used to communicate with a CMM, and because the KVM switch in *Huang* is integrated with each blade server to monitor and control the system and that each switch is coupled with the circuits on a chassis to provide for the transmission of signals to the management board, which manages the sockets of each chassis, that *Huang* reads on claim 19. Applicants respectfully disagree.

In essence, the Examiner is arguing that the KVM switch in *Huang* is equivalent to the firmware unit recited in claim 19. Applicants respectfully disagree. Nowhere in *Huang* is the

term “firmware” used. Moreover, even if the Examiner is correct in that firmware can be defined as software embedded into a hardware device, nowhere in *Huang* is the terminology disclosed. *Huang* appears to disclose that the KVM switch is “integrated” with the blade server. But this is to be viewed in its proper context. For instance, “integrated with the blade server” should be viewed as in contrast to a KVM switch that is *internal* to the chassis or a KVM switch that is *external* to the chassis, which *Huang* is trying to overcome. Applicants thus respectfully submit that *Huang* fails to expressly teach “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM” as recited in claim 19.

If the Examiner is arguing that *Huang* inherently discloses “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM” as recited in claim 19, Applicants respectfully disagree. To establish inherency, an Examiner must provide rationale or evidence tending to show inherency. MPEP §2112 IV. If relying on extrinsic evidence, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (MPEP §2112IV citing *In re Oelrich*, 666 F.2d 578, 581-582 (CCPA 1981)). If relying on rationale, an Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art (emphasis in original). (MPEP §2112IV citing *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

If the Examiner is relying on rationale to show that a “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM” is inherent in the KVM switch of *Huang*, Applicants respectfully submit that this rationale is faulty. There is no indication in *Huang* that the KVM switch is anything other than a hardware switch.

Assuming, for the sake of argument, that one could conclude that the KVM switch *Huang* could be “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM”, it does not necessarily flow from the teachings of *Huang* that the KVM switch *Huang* **must** be “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM.” As discussed above, the KVM switch in *Huang* could very well be a hardware switch. Accordingly, Applicants respectfully submit that the Examiner has failed to meet the burden of showing that “a firmware unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of the processing blade with the CMM” as recited in claim 19 is inherent in *Huang*. Because the Examiner has failed to show where *Huang* teaches at least this element of claim 19, Applicants respectfully submit that claim 19 is patentable over *Huang*.

Rejection of Claim 25 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claim 25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0268157 to Dake et al. (hereinafter “*Dake*”). Applicants respectfully traverse the rejection.

Independent claim 25 recites in pertinent part “***a flash memory unit*** communicatively coupled to the processor and ***having stored therein a virtual management controller*** (“VMC”), the processor to execute the VMC to communicate with the CMM during a management mode of operation of the processor to coordinate operation of each of the plurality of processing blades with the CMM” (emphasis added).

In the Office Action, the Examiner states that *Dake* teaches among other things a flash memory unit communicatively coupled to a processor and having stored therein a virtual management controller (citing paragraph [0022]) because a flash memory can be used as a nonvolatile storage for the processor connected to each blade and flash device stores the management module that is used to control resources of each blade server (citing paragraph [0019]). Applicants respectfully disagree.

In paragraph [0019], *Dake* states that the management module 120 in is “typically implemented with a management module service processor.” In paragraph [0022], *Dake* states that the management module 120 maintains the information in the power state table 140 in non-volatile memory, such as flash memory. Nowhere does *Dake* disclose “a flash memory unit communicatively coupled to the processor and having stored therein a virtual management controller (“VMC”)” as recited in claim 25. To the contrary, the management module service processor in *Dake* appears to be hardware rather than a software proxy layer. Because the Examiner has failed to show where *Dake* teaches at least this element of claim 25, Applicants respectfully submit that claim 25 is patentable over *Dake*.

Rejection of Claims 2- 4, 10, and 12-14 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 2, 4, 10, and 12-14 under 35 U.S.C. §103(a) as being obvious over *Yang* in view of U.S. Patent Publication No. US 2004/0030944 to Barr et al. (hereinafter “*Barr*”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, an Examiner must show that there is some expectation of success that the combination proffered would result in the claimed invention. The Examiner also must show that the cited references teach each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. (*Id.*).

Claims 2-4 and 10 properly depend from claim 1 and are thus patentable for at least the same reasons that claim 1 is patentable. Claims 12-14 properly depend from claim 11 and are thus patentable for at least the same reasons that claim 11 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 2, 4, 10, and 12-14.

Rejection of Claims 5-6 and 15-16 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 5-6 and 15-16 under 35 U.S.C. §103(a) as being obvious over *Yang* in view *Barr* in further view of U.S. Patent Publication No. US 2003/0188222 to Abbondanzio et al. (hereinafter “*Abbondanzio*”). Applicants respectfully traverse the rejection.

Claims 5-6 properly depend from claim 1 and are thus patentable for at least the same reasons that claim 1 is patentable. Claims 15-16 properly depend from claim 11 and are thus patentable for at least the same reasons that claim 11 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 5-6 and 15-16.

Rejection of Claims 20-22 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 20-22 under 35 U.S.C. §103(a) as being obvious over *Huang* in view *Barr*. Applicants respectfully traverse the rejection.

Claims 20-22 properly depend from claim 19 and are thus patentable for at least the same reasons that claim 19 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 20-22.

Rejection of Claim 23 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 23 under 35 U.S.C. §103(a) as being obvious over *Huang* in view *Barr*. Applicants respectfully traverse the rejection.

Claim 23 properly depends from claim 19 and are thus patentable for at least the same reasons that claim 19 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 23.

Rejection of Claim 24 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 24 under 35 U.S.C. §103(a) as being obvious over *Huang* in view *Barr* in further view of *Abbondanzio*. Applicants respectfully traverse the rejection.

Claim 24 properly depends from claim 19 and are thus patentable for at least the same reasons that claim 19 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 24.

Rejection of Claims 26-27 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 26-27 under 35 U.S.C. §103(a) as being obvious over *Dake* in view *Barr*. Applicants respectfully traverse the rejection.

Claims 26-27 properly depend from claim 25 and are thus patentable for at least the same reasons that claim 25 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 26-27.

Rejection of Claims 28-29 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 28-29 under 35 U.S.C. §103(a) as being obvious over *Dake* in view *Barr* in further view of U.S. Patent Publication No. US 2002/0016868 to Peacock (hereinafter "*Peacock*"). Applicants respectfully traverse the rejection.

Claims 28-29 properly depend from claim 25 and are thus patentable for at least the same reasons that claim 25 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 28-29.

Rejection of Claim 30 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 30 under 35 U.S.C. §103(a) as being obvious over *Dake* in view of *Abbondanzio*. Applicants respectfully traverse the rejection.

Claim 30 properly depends from claim 25 and are thus patentable for at least the same reasons that claim 25 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 30.

CONCLUSION

Applicants respectfully submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: July 24, 2007

/Jan Little-Washington, Reg. No. 41,181/

Jan Little-Washington

Reg. No. 41,181

(206) 292-8600

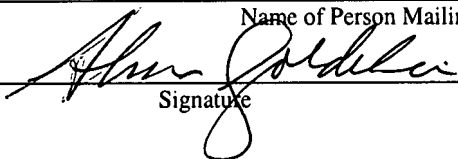
FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on July 24, 2007
Date of Deposit

Alma Goldchain

Name of Person Mailing Correspondence


Signature

7/24/07
Date